

### **REMARKS**

Claims 1-3, 6-7, 9-14, 18-19 and 22-23 were pending with claims 4-5, 8, 15, 20-21 being previously cancelled and claims 16-17 being provisionally withdrawn from consideration. By this paper, claim 1 has been amended and claim 6 has been cancelled. No claims have been added. Accordingly, upon entry of this paper, claims 1-3, 7, 9-14, 18-19 and 22-23 will remain pending.

#### **I. Formal Matters – Change In Docket Number**

Since the last communication, Applicant's representative wishes to inform the Office that the docket number for this matter has changed. The former docket number of 209546-104849 is now 225300-104849. Applicant requests that future communications reflect the updated docket number in order to facilitate accurate docketing and accounting for the present matter. Applicant thanks the Office for considering this request.

#### **II. Response to previous action**

Applicant acknowledges the Office's remarks in the previous action. Applicant, however, disagrees with the Office's characterization of Segawa's teachings as well as the combination of Segawa and Ogawa to reject the claimed invention. Applicant provides the following remarks, traversing the Office's statements asserted in the previous action.

##### **A. Structural Differences - Claimed Invention & U.S. 4,068,034 to Segawa et al. ("Segawa")**

Absent foundational support, the previous action states that "Segawa uses insulative materials with a similar structure." See previous action dated December 18, 2009. While Applicant acknowledges that the claimed invention and Segawa each teach the use of poly-based materials, Applicant submits that Segawa does not disclose, teach or suggest using such materials as an *interior trim panel* or as a vehicular *headliner*, both of which are required by the claims. Applicant does not acquiesce in this characterization of the claims and respectfully challenges the Examiner's apparent taking of Official Notice pursuant to 37 C.F.R. 1.104(d)(2) and MPEP § 2144.03 and seasonably requests support therefore. If evidence of such Official Notice is not provided, Applicant submits that all of the pending claims should be allowed.

Again, absent any foundational support, the previous action states that “[w]ith a reasonable expectation of success, it would have been obvious to a person of ordinary skill in the art of the time of the invention to have applied the heat insulation material of Segawa to the a [sic] non-flat contour vehicle panel as claimed by the Applicant since Segawa discloses that the insulation material is designed to prevent temperature of the vehicle interior from being elevated by heat. “This would allow for maximum head room and space in the vehicle.” See previous action dated June 25, 2009. Again, and with respect, Applicant does not acquiesce in this characterization by the Examiner.

U.S. Patent Publication No. 2004/0124668 to Ogawa (“Ogawa”), relied on by the Examiner to support an alternative 103 rejection, decries using materials such as those disclosed in Segawa as Ogawa clearly states that “[a] coating material suppressing absorption of solar radiation in the front surface of the outer panel, which is publicly known, for example, in a construction field, does not satisfy application requirements in a field which requires high designability like the outer panel of a vehicle.” Ogawa at Paragraph 7. Ogawa is specifically excluding that which is taught in Segawa. Thus, even those skilled in the art (Ogawa) *at the time of the invention*, teach that the prior art could not be used to achieve the desired function. Ogawa was filed many years after Segawa and still did not appreciate the disclosed structure. “[w]hen the prior art teaches away from combining certain known elements, discovery of succesful means of combining them is more likley to be non-obvious.” MPEP § 2143, A., 8<sup>th</sup> Ed. 6<sup>th</sup> Rev (July, 2008) (citing *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (Fed. Cir. 2007)). Accordingly, Applicant cannot acquiesce in this characterization of the claims and respectfully challenges the Examiner’s apparent taking of Official Notice pursuant to 37 C.F.R. 1.104(d)(2) and MPEP § 2144.03 and seasonably requests support therefore. If evidence of such Official Notice is not provided, Applicant submits that all of the pending claims should be allowed.

As a third point, Applicant has amended the claims to further expedite prosecution and illustrate how clearly different the invention is over the prior art. Applicant points out that Segawa’s film (i.e., see “3” in Figure 2) and priming material (i.e., see “6” in Figure 2) are attached by an *adhesive* (i.e., see “5” in Figure 2). Conversely, the film and core layer of the present invention are heated & bonded *without an adhesive* within a mold tool, as now recited in amended claim 1. Accordingly, it is submitted that the lack of an adhesive would actually structurally-

distinguish the claimed invention from the prior art, as Segawa teaches that the layers may be joined to structure with *nails & bolts* (see, e.g., col. 3, lined 37-40). Applicant respectfully submits that visible, passenger-compartment-facing *interior* trimming structure are not joined with “nails & bolts.” Not only are nails & bolts not aesthetically pleasing (i.e., while it may be acceptable to attach *exterior* panels with nails & bolts, an automobile user / customer is not very likely to desire a vehicle having an *interior* panel attached to structure with nails & bolts, as suggested by Segawa), but nails & bolts are not economically satisfactory for use with *interior* panels of automobiles (i.e., it is significantly cheaper to attach the film and core layer recited by the claimed invention via a thermo-bond rather than purchasing an adhesive or fasteners to join the film and a priming layer, as suggested by Segawa).

B. Segawa’s Panel is limited to an outer layer

In the previous action, it is recited that “Example 1 by Segawa shows the laminate material applied to the outer layer but the reference does not limit the laminate usage to the outer layer.” See previous action dated December 18, 2009. This is unsupported and Applicant respectfully submits that the Office is attempting to impermissibly expand Segawa’s disclosure. Why? As discussed above, Ogawa specifically states that applying materials to a “front panel” (i.e., an exterior panel) of a vehicle cannot satisfy application requirements in the field of vehicle panel design for absorbing solar radiation. Accordingly, Ogawa bolsters Applicant’s position that Segawa’s “construction field” exterior panel can not and should not be broadly applied or construed as a suggestion for an interior panel of an automobile as proposed by the Office.

In view of the fact that Ogawa further emphasizes that Segawa’s “construction field” exterior panel does not satisfy the high designability requirements of a vehicle panel, Applicant therefore respectfully submits that in order to render Segawa’s exterior panel structure as a suggestion for an interior panel, as recited by the invention, one skilled in the art would have to actually ignore the fact that Ogawa teaches away from exterior panel structures. Applicant therefore submits that the combination of Segawa and Ogawa would not yield a predicable result, as alleged by the Office, as shown above in the Final Office Action. The courts have been clear, “[w]hen the prior art teaches away from combining certain known elements, discovery of successful means of

combining them is more likely to be non-obvious.” MPEP § 2143, A., 8<sup>th</sup> Ed. 6<sup>th</sup> Rev (July, 2008) (citing *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (Fed. Cir. 2007)).

**2143 >Examples of< Basic Requirements  
of a *Prima Facie* Case of Obvious-  
ness**

**A. *Combining Prior Art Elements According to  
Known Methods To Yield Predictable Results***

obvious. The Court stated that “[d]espite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore” the teaching away of the prior art that such batteries were impractical and that water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium electrodes. *Id.* at 42-43, 50-52, 148 USPQ at 480, 483. “When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395.

In view of the law and the regulations, Applicant respectfully submits that Ogawa’s disclosure at paragraph [0007] affirms Applicant’s position that Segawa’s exterior panel would not and could not provide a suggestion of reasonable expectation of success or a predictable result if one skilled in the art were to utilize Segawa’s exterior panel as an interior panel. As a result, Applicant submits that the claimed invention is non-obvious in view of Segawa, when taken alone, or any permissible combination of Segawa and Ogawa. Withdrawal of the rejection is respectfully requested.

**III. Rejections of the claims under 35 U.S.C. 35 U.S.C. § 103**

- Claims 1-3 and 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 4,068,034 to Segawa et al. (“Segawa”).
- Claims 18-19 and 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Segawa in view of U.S. Patent Publication No. 2004/0124668 to Ogawa (“Ogawa”).
- Claims 9-14 and 18-19 were rejected 35 U.S.C. § 103(a) as being unpatentable over Segawa in view of Ogawa and in further view of U.S. Patent No. 4,851,283 to Holtrop (“Holtrop”).

In light of the remarks contained in this paper along with the amendments, Applicant submits that the rejections are overcome and solicits allowance.

Regarding Independent Claims 1, 9 and 18

At page 5 of the Final Office Action, the Office pointed to Segawa's teachings at col. 3, lines 24-28 in order to show support for the attachment of Segawa's material to a base structure. As stated above, Applicant respectfully submits that Segawa's material is not and may not function as an *interior trim panel* as required by the current claims. Rather, per col. 3, lines 24-39, Segawa's material is an *exterior* component.

Referring to section II of this paper, it has been again-submitted that Segawa's material is not an *interior* panel such that it is exposed to a vehicle's interior / passenger compartment area, but, rather, as even emphasized by Ogawa, Segawa's panel is not conducive as an *interior* panel; accordingly, Segawa's panel is ***limited to being*** applied relative a vehicle's exterior structure. Support for Applicant's position comes from the following of Segawa's specification at col. 3, lines 17-39:

- the upper surface of the layer 3 in FIG. 2 (faces) the direction of the source of radiant heat; and
- applying adhesive binding agent directly to the exposed surfaces of the articles and then bringing the rear surface (priming layer surface) of the heat insulation material into contact with the applied layer of adhesive.

In view of the above remarks, Applicant submits that none of Segawa, Ogawa and Holtrop when taken individually or in any permissible combination teaches, suggests or discloses the claimed invention.

Although Applicant has distinguished between the claimed invention and the art of record, Applicant believes that no amendments to the claims are needed to patentably-distinguish the claimed invention from the prior art. However, Applicant has elected to amend claim 1 to include the limitations recited in claim 6 (i.e., "*wherein said interior trim panel comprises a headliner*") as well as the fact that the layers are bonded "*without an adhesive.*" Applicant submits that persons skilled in the art are familiar with the fact that headliners are located in the *interior* of a passenger compartment area for trimming vehicle structure; headliners are not found on a vehicle's exterior structure nor are headliners designed to functionally protect a vehicle's exterior.

No amendments to claims 9 and 18 are provided in this paper. Applicant notes that independent claim 18 already recites a “headliner.” Applicant also notes that independent claim 9 positively recites “*a structural outer roof panel of a vehicle having a non-flat, contoured, passenger-compartment-facing inboard surface*” in order to establish a frame of reference such that the “*heat formable metalized film layer forms a non-flat topography of an outboard surface of the passenger compartment interior trim panel that matches the non-flat, contoured, passenger-compartment-facing inboard surface of the structural outer roof panel of the vehicle without an air gap between the structural outer roof panel of the vehicle and the passenger compartment interior trim panel.*”

For at least the above reasons, independent claims 1, 9 and 18 are allowable over any permissible combination of the art of record. Claims 2-3 and 7 depend from independent claim 1, claims 10-14 and 16-17 depend from independent claim 9 and claims 19 and 22-23 depend from independent claim 18 and each include patentably-distinct limitations. For at least the above remarks, the rejections to claims 1-3, 7, 9-14, 16-19 and 22-23 should be withdrawn. Allowance of claims 1-3, 6-7, 9-14, 16-19 and 22-23 is requested.

#### Conclusion

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3145, under Order No. 225300-104849 from which the undersigned is authorized to draw.

Dated: 3/30/2010

Respectfully submitted,

By Thomas J. Appledorn

Thomas J. Appledorn

Registration No.: 59,348

HONIGMAN MILLER SCHWARTZ AND  
COHN LLP

38500 Woodward Avenue

Suite 100

Bloomfield Hills, Michigan 48304-5048

(248) 566-8522

Attorney for Applicant